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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/358,529	07/22/1999	FUJIO NOGUCHI	450100-02002	1683
20999	7590	03/23/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			WU, DOROTHY	
			ART UNIT	PAPER NUMBER
			2615	13
DATE MAILED: 03/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/358,529

Applicant(s)

NOGUCHI ET AL.

Examiner

Dorothy Wu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed January 2, 2004 have been fully considered but they are not persuasive.

The applicant has argued: "Wakui as applied by the Examiner does not appear to disclose 'control means for causing said first recording mode to be set automatically when the loading of said first recording medium is detected by detection means.' Rather, it appears that the mode is manually set by a mode selection switch and may be actuated when the IC card memory is inserted." The office respectfully disagrees. Wakui does indeed teach a manual selection of a mode (col. 5, lines 31-33). However, Wakui also teaches that when the IC memory card is loaded, the recording of image data in the flash memory is stopped, the memory card record mode is set, and recording in the IC memory card begins (col. 19, lines 48-53, Fig. 16), which reads on an automatic setting of the first recording mode when the first recording medium is detected.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claims 2 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Wakui, U.S. Patent 5,648,816.

Regarding claim 2, Wakui teaches an image capturing apparatus (still video camera **1**) comprising first operation means (IC memory card control circuit **15**) for recording an image-capturing signal on a first recording medium (IC memory card **31**) in accordance with a first recording mode (memory card record mode) (col. 5, lines 43-46, 53-56; Fig. 4), second operation means (flash memory control circuit **19**) for recording an image-capturing signal on a second recording medium (image flash memory **20**) in accordance with a second recording mode (flash memory record mode) (col. 6, lines 32-38; Fig. 5), and detection means (memory card detecting circuit **16**) for detecting the loading of said first recording medium (IC memory card **31**) (col. 5, lines 64-67). Wakui also teaches that when the IC memory card is loaded, the recording of image data in the flash memory is stopped, the memory card record mode is set, and recording in the IC memory card begins (col. 19, lines 48-53, Fig. 16), which reads on an automatic setting of the first recording mode when the first recording medium is detected. The control means for setting the recording mode is inherently taught.

Regarding claim 3, Wakui teaches an image capturing apparatus (still video camera **1**) that can switch between a first operation mode (memory card record mode) for recording an image-capturing signal on a first recording medium (IC memory card **31**) and a second operation mode (flash memory record mode) for recording an image-capturing signal on a second recording medium (image flash memory **20**) (col. 8, lines 24-41, 54-60), and detection means (memory card detecting circuit **16**) for detecting the loading of said first recording medium (IC memory card **31**) (col. 5, lines 64-67). The control means for switching the operation mode is

inherently taught. Wakui also teaches that when the IC memory card is loaded, the recording of image data in the flash memory is stopped, the memory card record mode is set, and recording in the IC memory card begins (col. 19, lines 48-53, Fig. 16), which reads on an automatic setting of the first recording mode when the first recording medium is detected.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakui, U.S. Patent 5,648,816 in view of Honda, U.S. Pub. No. 2001/0014202.

Regarding claim 4, Wakui teaches an image capturing apparatus (still video camera **1**) that can switch between a first operation mode (memory card record mode) for recording an image-capturing signal on a first recording medium (IC memory card **31**) and a second operation mode (flash memory record mode) for recording an image-capturing signal on a second recording medium (image flash memory **20**) (col. 8, lines 24-41, 54-60); and detection means (memory card detecting circuit **16**) for detecting the loading of said first recording medium (col. 5, lines 64-67). The control means for switching the operation mode is inherently taught. Wakui also teaches that when the IC memory card is loaded, the recording of image data in the flash memory is stopped, the memory card record mode is set, and recording in the IC memory card

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begins (col. 19, lines 48-53, Fig. 16), which reads on an automatic setting of the first recording mode when the first recording medium is detected.

Wakui does not teach that in the first operation mode, the image sensing apparatus records an image-capturing signal as a still picture and in the second operation mode, the image sensing apparatus records the signal as a moving picture. Honda does teach that in a first operation mode  $P_H$ , the image sensing apparatus records an image-capturing signal as a still picture and in a second operation mode  $M_V$ , the image sensing apparatus records the signal as a moving picture [0079]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the practice of choosing a particular operation mode when a first recording medium is inserted taught by Wakui with the practice of recording still images in one mode and moving images in another taught by Honda to make an apparatus wherein the image sensing apparatus switches to a mode to take still images when an image recording medium is inserted. One of ordinary skill would have been motivated to make such a modification to assign one recording mode as the default mode but give the other mode priority when a recording medium is inserted.

Regarding claim 5, Wakui teaches an image capturing apparatus (still video camera 1) that can switch between a first operation mode (memory card record mode) for recording an image-capturing signal on a first, card recording medium (IC memory card 31) and a second operation mode (flash memory record mode) for recording an image-capturing signal on a second recording medium (image flash memory 20) (col. 8, lines 24-41, 54-60); and detection means (memory card detecting circuit 16) for detecting the loading of the card recording medium, which reads on the determining of whether said card recording medium is loaded (IC

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memory card **31**) (col. 5, lines 64-67). Wakui also teaches that when the IC memory card is loaded, the recording of image data in the flash memory is stopped, the memory card record mode is set, and recording in the IC memory card begins (col. 19, lines 48-53, Fig. 16), which reads on an automatic setting of the first recording mode when the first recording medium is detected. The control means for setting the recording mode is inherently taught.

Wakui does not teach that in the second mode, the image sensing apparatus records the image-capturing signal as a moving picture on a tape recording medium. Honda does teach that in a second mode  $M_V$ , the image sensing apparatus records the image-capturing signal as a moving picture [0079] on a tape recording medium [0061, 0074]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the practice of choosing a particular operation mode when a card recording medium is inserted taught by Wakui with the practice of recording still images on a card recording medium in a first mode and moving images on a tape recording medium in a second mode taught by Honda to make an apparatus wherein the image sensing apparatus switches to a mode to take still images on a card recording medium when a card recording medium is inserted. One of ordinary skill would have been motivated to make such a modification to make the video recording mode the default mode but give still image pickup priority when a card recording medium is inserted.

Regarding claim 6, Wakui teaches an image capturing apparatus (still video camera **1**) comprising first operation means (IC memory card control circuit **15**) for recording an image-capturing signal on a card recording medium (IC memory card **31**) in accordance with a first recording mode (memory card record mode) (col. 5, lines 43-46, 53-56; Fig. 4), second operation means (flash memory control circuit **19**) for recording an image-capturing signal on a

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second recording medium (image flash memory 20) in accordance with a second recording mode (flash memory record mode) (col. 6, lines 32-38; Fig. 5), and detection means (memory card detecting circuit 16) for determining whether said card recording medium (IC memory card 31) is loaded (col. 5, lines 64-67). Wakui also teaches that when the IC memory card is loaded, the recording of image data in the flash memory is stopped, the memory card record mode is set, and recording in the IC memory card begins (col. 19, lines 48-53, Fig. 16), which reads on an automatic setting of the first recording mode when the first recording medium is detected. The control means for setting the recording mode is inherently taught.

Wakui does not teach that the second operation means records on a tape recording medium. Honda teaches an apparatus in which there is a second mode  $M_V$  in which the image sensing apparatus records the image-capturing signal as a moving picture [0079] on a tape recording medium [0061, 0074]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the practice of choosing a particular operation mode when a card recording medium is inserted taught by Wakui with the practice of recording images on either a card recording medium or a tape recording medium taught by Honda to make an apparatus wherein the image sensing apparatus switches to a mode to record images on a card recording medium when a card recording medium is inserted. One of ordinary skill would have been motivated to make such a modification to make the mode in which images are captured on a tape recording medium the default mode but give priority to capturing images on a card recording medium when a card recording medium is inserted.



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*Conclusion*

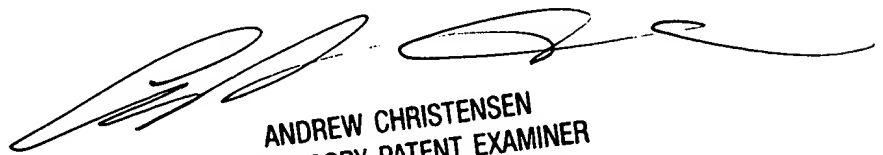
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dorothy Wu whose telephone number is 703-305-8412. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on 703-308-9644. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Dorothy Wu*

DW  
March 11, 2004

  
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